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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/830,104	04/24/2001	Ernst F. Schroder	PD 980069	2826	
7590	10/06/2004	EXAMINER			
PHAM, THOMAS K					
ART UNIT		PAPER NUMBER			
2121					

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/830,104	SCHRODER, ERNST F. 
Examiner	Art Unit	
Thomas K Pham	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 April 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date, _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/23/01</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**First Action on the Merits**

1. Claims 1-7 of U.S. Application 09/830,104 filed on 04/24/2001 are presented for examination.

**Quotations of U.S. Code Title 35**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

### **Claim Rejections - 35 USC § 112**

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase “e.g.” (for example, in line 8 and 10 of the preliminary amendment) renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 1, the word “either” or “or” (for example, in line 8 and 10 of the preliminary amendment) renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### **Claim Rejections - 35 USC § 102**

7. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,122,758 (“Johnson”).

#### **Regarding claim 1**

Johnson teaches system having a plurality of devices connected to one another via a bus interface, in particular an IEEE 1394 bus interface (col. 7 line 18), wherein one of the devices contains a control unit which, when operated appropriately by a user, polls system data for other devices in this system via the interface, wherein said system data comprises characteristic data for a device (col. 16 lines 52-64, “If the SDA and SDL lines ... the microcontroller bus 310”), and passes this system data to an output unit of this one device, the output unit being either a device for writing to a mobile, digital data medium which can store the system data (col. 18 line

66 to col. 19 line 4, “the Chassis controller 318 reads … in the NVRAM 322”) or the output unit being a modem or another telecommunication connection which, when operated appropriately by a user, can send the system data to a desired address [Examiner is only considered the “digital data medium” limitation over the prior art based on the interpretation of the claim that renders the prior art applicable].

**Regarding claim 4**

Johnson teaches this one device having the device for writing to the data medium is a minicomputer having a drive for a floppy disk or another data medium having a magnetic or optical storage medium (col. 5 lines 42-64, “The system includes a fault … multiple Gigabytes of data”).

**Regarding claim 5**

Johnson teaches this one device contains a control unit which, when operated appropriately by a user, polls system data for the connected other devices via an interface (col. 16 lines 52-64, “If the SDA and SDL lines … the microcontroller bus 310”) wherein this one device includes a device for writing to a mobile, digital data medium and wherein the device stores this system data on the data medium using the device (col. 18 line 66 to col. 19 line 4, “the Chassis controller 318 reads … in the NVRAM 322”).

**Regarding claim 6**

Johnson teaches this one device contains a control unit which, when operated appropriately by a user, or when an appropriate remote polling code is received, polls system data for the connected other devices via an interface (col. 16 lines 52-64, “If the SDA and SDL lines … the microcontroller bus 310”) wherein this one device includes a modem or another

telecommunication connection which can send the polled system data to a desired address (col. 7 lines 42-54, “Two wires, serial data (SDA) ... addressed is considered a slave”).

**Regarding claim 7**

Johnson shows user operation corresponds to remote control in the context of a remote polling code transmitted via communication line or by radio (fig. 4, remote computer 330 communicates with computer 100 via modem line).

**Claim Rejections - 35 USC § 103**

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of U.S. Patent No. 6,266,809 (“Craig”).

**Regarding claim 2**

Johnson does not teach the mobile data medium is a smart card or a chip card having a memory, and in that, when operated appropriately by a user, the control unit in this one device stores system data for the connected other devices on the smart card or the chip card using the device. However, Craig teaches the mobile data medium is a smart card having a memory (fig. 2, element 220) and in that, when operated appropriately by a user, the network computer [device] communicate with the smart card for storing system data (col. 5 lines 57-67, “FIG. 2 also illustrates ... central processing unit 222”) for the purpose of allowing secure information to be store in its memory. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the smart card of Craig with the system of Johnson because it would provide for the purpose of allowing secure information to be store in its memory.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of U.S. Patent No. 6,112,085 (“Garner”).

**Regarding claim 3**

Johnson does not teach this one device having the device for writing to the data medium is a set-top box or a digital satellite receiver having a write/read device for a chip card or a smart card. However, Garner teaches a mobile satellite system having a write/read device for a chip card or a smart card (col. 39 lines 29-38, “Disk Drive Unit (DDU) ... office data modification”) for the purpose of providing storage for different output files. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the satellite system of Garner with the system of Johnson because it would provide for the purpose of providing storage for different output files.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (703) 305-7587 or the new number (571) 272-3689 beginning Oct. 13<sup>th</sup>, 2004, Monday - Friday from 8:00 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (703) 308-3179 (or (571) 272-3687 starting Oct. 13<sup>th</sup>, 2004).

Any response to this office action should be mailed to: **Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.** Responses may also be faxed to the **official fax number (703) 872- 9306.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Thomas Pham**  
*Patent Examiner*

*TP*

September 30, 2004



**Anthony Knight**  
Supervisory Patent Examiner  
Group 3600